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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,852	04/21/2000	Charles A. Lieder	013129/00025	6369

7590

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

17

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-17

Office Action Summary

Application No.

01/552,852

Applicant(s)

LIEDER et al

Examiner

NEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 8/27/01; 1/28/02

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above claim(s) is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-29 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claim(s) are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. .

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: .

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5,7,

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other .

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DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly claimed limitation "combining a neat blend of hydrocarbons with an alcohol" in claims 23 and 26 is considered as new matter. Originally filed claims 23 and 26 required the presence of blending at least two hydrocarbon streams to produce a gasoline". The amended claims require the presence of a neat blend of hydrocarbons. The marked-up copy of the claims does not reflect the said changes. Claim 26 as amended does not provide for the blending step of claim 28.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-17 for reasons made of record in paper No. 6 dated April 11, 2001 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Orr 6,039,772, column 14, line 50 to column 17, lines 1-17 and claims 1, 2, and 7.

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Claims 1-4, 7-13 and 16-17 for reasons made of record in Paper No. 6 dated April 11, 2001 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by the Redacted Gasoline Data from a Third Party Source, note page 1 for Example 2; and the Gasoline Data from a Third Party Source, note page 1 for Example 2; and the Gasoline Data from a Third party, note page 1/15 for Example 1.

Claims 5-6 and 14-15 for reasons made of record in Paper No. 6 dated April 11, 2001 remain rejected under 35 U.S.C. 102(b) as being anticipated by the Redacted Gasoline Data from a Third Party, note page 1-15 for Example 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-22 for reasons made of record in Paper No. 6 dated April 11, 2001 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Malfer et al 6,048,373 combined with Jessup et al 5,288,393.

Claims 1-29 for reasons made of record in Paper No. 6 dated April 11, 2001 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Niebylski 4, 317 657 in view of Cunningham et al 5,551,957 and 5,679,116.

Claims 1, 4-9, 13-18 and 21-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jarvis et al (Jarvis) 5,679,117, note column 5, lines 3-29 and 65-67, column 6 lines 3-4 and 20-28.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

DRP Claims 1, 4-9, 18-19 and 21-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Scott et al (Scott) 6,290,734B1, note the last examples of the last Table.

Applicant's arguments filed August 27, 2000 have been fully considered but they are not persuasive.

In response to applicant's argument that Orr does not recite any RVP for the resulting formulation for gasoline containing an alcohol, particularly ethanol, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It is further pointed out to applicant that the examiner has relied on the teachings of Orr in claims 1, 2 and 7 (8) requiring the present of 0.05-14.2 weight percent oxygen selected from ethanol and methanol and mixtures thereof. The examiner takes the position on record that the neat gasoline fuels of Orr covers a large variety of commercially available neat gasoline fuels having RVP of less than 7.2 (note claim 39) having 0.05 to 14.2 of an oxygenate (claim 29) that includes ethanol (claim 37) that anticipates the RVP of less than 7.0, 7.1; greater than 5.8, 9.6 and 5.0 alcohol, and ethanol of the instant claims. It is reasonable expected that the fuel composition of Orr would inherently have the same RVP and alcohol content.

Applicants argue that the rejection based on the Redacted Gasoline Data/Gasoline data should be withdrawn because the said data relied upon by the Examiner is an outlier based on paragraph 5 of the Affidavit of Michelle Ratchford. The Examiner have carefully studied and reviewed the said Affidavit. However, the examiner did not find explicit language stating that the data presented therein was due through a typographical error or any other error other than that the "RVP for said

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gasoline is unusual and outside of the range of the data that would have normally been anticipated for the June, 1992 time period.


The previous 112 rejection over claims 23-29 and the 103 rejections over Malfer and Jessup, and Niebylski and Cunningham et al are withdrawn in view of applicants arguments made of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Examiner Medley/ng
June 4, 2002


MARGARET MEDLEY
PRIMARY EXAMINER